

REMARKS

In the March 16, 2006 Office Action, claims 1-10 were rejected under the first paragraph of 35 USC 112; claims 1 and 7-10 were rejected under 35 USC 102(e) as anticipated by Shwartz (US Patent Application Publication No.2001/0044787); and claims 2-6 were rejected under 35 USC 103(a) as obvious from Shwartz in combination with one or more of an article by Lamond; Martinez (US Patent 5,208,446); and Lalonde (US Patent 5,477,040).

In item 8 on page 7 of the Office Action, grounds of rejection were presented for claims 4 and 6. However, there was no discussion of why claim 6 was rejected. Thus, since claim 6 apparently was not examined, it is respectfully requested that the next Office Action be non-final.

Claims 4, 9 and 10 are herein canceled. Claims 1 and 6-8 are herein amended. Thus, claims 1-3 and 5-8 are pending and under consideration. The rejections are traversed below.

Rejections under 35 USC § 112, First Paragraph

In item 2 on pages 2 and 3 of the Office Action, claims 1-10 were rejected under 35 USC § 112, first paragraph because the claims contain "subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention" (Office Action, page 2, lines 18-21). Specifically, the claim language that allegedly does not find support is:

a transaction supporting apparatus in supporting making payment of a transaction including transaction-detail registering means for registering details of a transaction; including information about a credit card account of the buyer without revealing credit card information to the seller

(Office Action, page 3, lines 13-16). The actual claim language referred to above before amendment recited "transaction-detail registering means for registering details of the transaction, including information about a credit card account of the buyer without revealing credit card information to the seller" (claim 1, lines 4-6, Amendment filed 12/5/05) and is supported in FIG. 7; FIG. 17; at page 11, line 20 to page 12, line 3; page 12, lines 10-21; and page 28, lines 12-20 of the specification. It is submitted that the amended claim language is likewise supported by the specification.

Additional claim language that allegedly did not find support was "charging means for charging by the intermediary agent for the transaction without revealing credit card information to the seller as implied in claims 1, 7-10" (Office Action, page 3, lines 17-18). These features are

not implied and find support in on page 9, lines 7-19; page 11, line 20 to page 12, line 3; FIG. 3; and FIG. 7 of the specification. Thus, for at least all of the above reasons, it is respectfully requested that the rejections under 35 USC § 112, first paragraph for claims 1-10 be withdrawn.

Rejections under 35 USC § 102

In item 4 on pages 4 and 5 of the Office Action, claims 1 and 7-10 were rejected under 35 USC § 102(e) as anticipated by US Patent Application Publication No.2001/0044787 to Shwartz.

Claim 1 as amended recites "registering means for registering the credit card information received via the delivery service agent, together with the membership number of the buyer" (claim 1, lines 11-14) which is consistent with the disclosure of the invention illustrated in FIGS. 7, 17 and 19, and at page 11, line 20 to page 12, line 3; page 12, lines 10-21; page 21, lines 12-24; and page 28, lines 12-20 of the application.

What was cited in Shwartz was that a "consumer 10, having registered, and shopped, arrives at a desired electronic commerce site 20" (Shwartz, paragraph [0169]). In other words, what was cited in Shwartz is silent on "registering ... credit card information received via the delivery service agent, together with the membership number of the buyer" as recited in claim 1.

What was cited in Shwartz as disclosing "payment information notifying means for notifying the buyer of payment information including information about a bank account of the seller into which the buyer is requested to transfer money by other means than the registered credit card account before the specified deadline expires" (claim 1, lines 13-16) was that "electronic commerce site 66 sends confirmation information, optionally with a reference number. The confirmation is intercepted by the back-end gateway 50, and is relayed to the consumer 10" (Shwartz, paragraph [0196]). In other words, this portion of Shwartz describes sending a confirmation number confirming a transaction to a consumer without any mention of "a bank account of the seller" as recited in claim 1. Furthermore, this portion of Shwartz contains no mention of how the consumer is to "transfer money by other means than the registered credit card account before the specified deadline expires" as recited in claim 1. Thus, what was cited in Shwartz does not teach or suggest each element of claim 1; a *prima facie* case of anticipation was not established; and claim 1 is therefore allowable.

Claims 7 and 8 recite "registering" limitations and "payment ... deadline" limitations in a manner similar to claim 1. Claims 2, 3, 5 and 6 depend from claim 1. Thus, claims 2, 3 and 5-8 distinguish over the applied art for the reasons discussed in regard to claim 1.

Rejections under 35 USC § 103

In item 6 on pages 5 and 6 of the Office Action, claim 2 was rejected under 35 USC § 103(a) as unpatentable over Shwartz.

Claim 2 recites "wherein said charging means charges for the transaction via the credit card account of the buyer when a given period described in the reminder message has expired" (claim 2, lines 5-6). The Examiner stated that the limitations of claim 2 are allegedly "old and well known in the art" (Office Action, page 5, lines 20-21).

The limitations recited in claim 2 are not considered well-known because they are not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, the limitation charging "for the transaction via the credit card account of the buyer when a given period described in the reminder message has expired" as recited in claim 1 is unique to the present invention. There is no evidence supporting the Examiner's assertion as required by MPEP § 2144.03(A) and (B). Therefore, the Applicant demands the Examiner produce authority for the statement or produce and affidavit in support of such an assertion.

In addition, as noted above, claim 2 is allowable because it depends from claim 1.

In item 7 on page 6 of the Office Action, claim 3 was rejected under 35 USC § 103(a) as unpatentable over Shwartz in view of Lamond. Claim 3 recites: "remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer" (claim 3, lines 2-3). What was cited in Lamond describes subtracting "transaction fees" (Lamond, page 7, item 7) from an amount paid to the merchant's account from the buyer. What was cited implies that Lamond's "transaction fees" are equated with Applicant's "service fee" as recited in claim 3. However, nothing was cited or found in Shwartz and Lamond that teaches or suggests a "service fee" as recited in claim 3 and supported in the specification describing an "intermediary service fee" (specification at page 8, lines 10-11). Furthermore, nothing was cited or found in Shwartz and Lamond either considered together or taken individually that teaches or suggests the limitations of claim 3. Nothing was cited or found in Shwartz and Lamond either considered together or taken individually that teaches or suggests motivation to either combine Lamond with Shwartz or motivation to modify Shwartz to derive the limitations admittedly missing from Shwartz. In addition, as noted above, claim 3 is allowable because it depends from claim 1.

In item 8 on page 7 of the Office Action, claims 4 and 6 were rejected under 35 USC § 103(a) as unpatentable over Shwartz in view of Martinez (US Patent 5,208,446). The rejection of claim 4 is moot because claim 4 is herein canceled. As noted above, no discussion of claim 6 could be found in the Office Action. As a result, it is impossible to respond to the rejection of

claim 6 and it is respectfully requested that the next Office Action not be made final. In addition, as noted above, claim 6 is allowable because it depends from claim 1.

In item 9 on pages 8 and 9 of the Office Action, claim 5 was rejected under 35 USC § 103(a) as unpatentable over Shwartz in view of Lalonde (US Patent 5,477,040). In the Office Action, it was admitted that Shwartz "does not explicitly disclose charging for the transaction if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer" (Office Action, page 8, lines 11-14).

Claim 5 recites "charging means charges for the transaction via the credit card account if said payment confirming means finds that said bank account of the buyer does not have a balance sufficient for the payment to be made by the buyer" (claim 5, lines 3-5). What was cited in Lalonde describes "selection of a specific charge card of a plurality of charge cards held by the card holder" (Lalonde, column 9, lines 37-40). Nothing was found in Lalonde regarding conditionally charging the selected card "if said payment confirming means finds that said bank account of the buyer does not have a balance sufficient for the payment" as recited in claim 5. Thus, Shwartz and Lalonde either considered together or taken individually do not teach or suggest all the limitations of claim 5. Furthermore, nothing was cited or found in Shwartz and Lalonde either considered together or taken individually that teaches or suggests motivation to either combine Lalonde with Shwartz or motivation to modify Shwartz to derive the limitations admittedly missing from Shwartz. In addition, as noted above, claim 5 is allowable because it depends from claim 1.

For all of the above reasons, claims 2, 3, 5 and 6 are allowable.

CONCLUSION

It is submitted that the applied references either combined together or considered individually do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-3 and 5-8 are in condition suitable for allowance. Reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/804,039

Finally, if there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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